

REMARKS

Claims 2 and 4-21, 24-30 are pending in this application. Claims 22 and 23 have been canceled (the subject matter of claim 23 being incorporated into claim 18). Claims 4, 17, 18, 20, 23, 25, 27, 28, 29, 30 have been amended. As to the amendment to claim 18, see, e.g., Applicants' specification at page 4, line 20. The amendment to claims 17-18, 20 to delete "textile fibers", "textile pieces" and "cork flour" and the cancellation of claim 22 are consistent with the claims in the German counterpart application.

An IDS is filed herewith which provides a translation of one of the documents submitted with the IDS filed January 12, 2007.

At paragraph 1 of the office action, the specification has been objected to. The Examiner states: "Antecedence has not been found within the specification for claiming that the molecular weight of claim 11 is weight average molecular weight." Applicants respond as follows. Applicants' original claim 11 is part of the specification, and the original claim 11 recites "molecular weight (weight average)." Therefore the recitation is proper.

At paragraph 2 of the office action, the amendment filed June 21, 2005 has been objected to under 35 U.S.C. 132(a) as introducing new matter. To advance prosecution, the objected-to recitation in the amendment has been removed from the specification.

At paragraph 3 of the office action, Claims 2 and 4-30 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite.

[1] Regarding claims 17, 18 and 23, the Examiner states that "it is unclear how the gel can be clear since it includes opaque particles. It is not clear if the 'optically clear' limitation is to apply to the gel sans particles." [2] The Examiner comments that claim 23 fails to further limit claim 18.

To highlight that the gel is "optically clear", claims 17 and 18 have been revised so that it can be seen that the gel constitutes one part of the composition, and the coarse grain particles of cork for example constitute another part of the composite. As explained in the application, the optically clear quality is very important to the invention, as it allows the particles to be seen (e.g., the shoe soles or insoles look like cork as opposed to plastic, as is the case with very fine

particles which are used as a filler). See also pages 9 and 10 of the March 1, 2005 amendment. See also, “The combination of the gel, which is as clear as glass in the basic state, with the irregular solid gives an attractive appearance to the composite material”. (Applicants’ specification, page 4, lines 12-13). For example, “The composite material is visibly grainy.” (Id., page 4, line 10.) “Since the particles can be recognized discretely, a visually novel gel composite material is produced.” (Id., page 3, lines 27-28.) The appearance of the composite material of this invention may be visualized as that of a compacted/molded coarse-grain cork material (for example, for shoe soles).

[3] Regarding claims 4, 17, 18 and 30, the Examiner states that “it is unclear what limitation is to be conveyed by ‘substantially.’”

Applicants respond as follows. The claims are amended to remove the word “substantially” added by previous amendment.

Reconsideration and withdrawal of the rejection under 35 U.S.C. 112, second paragraph, are respectfully requested.

At paragraph 5 of the office action, claims 2 and 4-30 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that “Applicants have failed to provide adequate support for the amendments to claims 4, 17, 18 and 25-30.” The Examiner refers to claim amendments reciting “substantially” and “about”.

Applicants respond as follows. The terms “substantially” and “about” on which this rejection was based have been avoided in amending the claims above.

Reconsideration and withdrawal of the rejection under 35 U.S.C. 112, first paragraph, are respectfully requested.

At paragraph 6 of the office action, claims 2 and 4-30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Schapel et al. (‘834) in view of Ehrlich, Jr. (‘702) and Fracalossi et al. (‘221). This rejection is traversed.

The Examiner admits that “Schapel et al. fail to specifically recite the use of coarse materials to form a composite.”

Additionally, Schapel fails to disclose that the coarse-grain particles are “distributed therein” in the gel. Schapel also fails to disclose, specifically, that the coarse-grain particles are “selected from the group consisting of cork pieces, wood pieces, wood chips, and foam flakes”. Schapel also fails to teach that “the

diameter of the coarse-grain solid particles is in a range between 0.1 mm to 15 mm". Schapel also fails to teach a material in which the "particles can be visually recognized" (i.e., one which is visibly grainy as required in claim 18).

In Schapel, titled "Gel compounds, their production and use," there is teaching that "The fillers and/or additives known per se from polyurethane chemistry optionally present in the gel compounds according to the invention may be, for example, inorganic and/or organic fillers, coloring agents, water-binding agents, surface-active agents, plant protection agents, extending agents and/or plasticizers." (Sentence bridging columns 6-7.) However, none of the many optional fillers and additives in Schapel are cork pieces, wood pieces, wood chips, or foam flakes, as recited by Applicants.

It has been suggested that one of ordinary skill in the art might look to Fracalossi or Ehrlich to identify materials which might be substituted for the "fillers" or Shapel. This is simply not correct.

First, both Fracalossi and Ehrlich are directed to foams, not to gels. Both secondary references fail to teach or disclose working with gels.

Second, this type of combination misinterprets what is meant by fillers in Shapel. In contrast to a filler, which fits within the plastic to provide rigidity, etc., the focus of the present invention is to have coarse-grain particles which are "seen" by the user. That is, when one views the insoles or other products made according to the claimed invention, he or she sees something that looks like cork pieces, wood chips, foam flakes, etc. In contrast, in a plastic with a filler, one would get an opaque or translucent plastic material where one does not "see" particles within a clear gel.

Finally, completely unrecognized by any of Shapel, Fracalossi, or Ehrlich are the unexpectedly superior results achieved with the claimed invention compared to Schapel's materials, as to visual appearance. (See Applicants' specification at pages 3-4.)

Applicants also note that their dependent claims are more distinguished from Schapel than the Examiner has yet admitted.

Regarding dependent claim 2, Applicants note that this is additionally distinguished from Schapel in that Schapel fails to disclose a composite material having a lowered loss factor compared to a polyurethane gel alone. For brevity

and simplicity, Applicants do not submit additional distinguishing remarks for each dependent claim at this time.

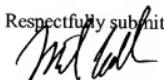
For these several reasons, reconsideration and withdrawal of the obviousness rejection are respectfully sought.

In view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 2, 4-21, 24-30 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis, Christofferson & Cook, P.C.).

Respectfully submitted,



Michael E. Whitham
Reg. No. 32,634

Whitham, Curtis, Christofferson & Cook, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190

Tel. (703) 787-9400
Fax. (703) 787-7557

Customer No.: 30743